



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,006	02/04/2000	Dr. Paddy Jim Baggot	13635.4001	9604
34313 7590 09/14/2007 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558			EXAMINER JOHANNSEN, DIANA B	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09499006	2/4/00	BAGGOT, DR. PADDY JIM	13635.4001

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

EXAMINER

Diana B. . Johannsen

ART UNIT	PAPER
1634	20070913

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Please see enclosed communication regarding non-responsive amendment.

Diana B. Johannsen
Primary Examiner
Art Unit: 1634

Art Unit: 1634

1. The amendment filed on June 21, 2007 amending all claims previously drawn to the elected invention (claims 15-16 and 18-24) such that they are now drawn to a non-elected invention is non-responsive (see MPEP § 821.03).

The claims as amended are not readable on the elected invention because they are no longer drawn to methods of identifying Down Syndrome in a fetus. Applicant is referred to the restriction set forth in the action of February 26, 2002, in which the claims were restricted between Group I (drawn to methods of treating Down Syndrome) and Group II (methods of identifying Down Syndrome), and to the Response of March 25, 2002, in which Group II was elected. The claims as presently amended no longer encompass Down Syndrome identification or an equivalent method (e.g., Down Syndrome diagnosis or detection), and no longer include any steps of identification, diagnosis, detection, etc., of this condition. Rather, the claims are now drawn to screening methods in which an "abnormal metabolite" is identified. The presently claimed methods differ in both function and effect from those of elected Group II. Further, a search of the methods as now claimed would require the use of different search terms aimed at identifying different types of prior art references pertinent to the screening methods now claimed, such that a search of both inventions would impose a serious search burden. Accordingly, the invention of present claims 15-16 and 18-24 would have been properly restricted from that of original Groups I and II had that invention been originally presented. While it is noted that applicant has filed an RCE in the instant application, the Office does not generally permit a shift to claiming another invention even in an RCE (see MPEP 819).

Art Unit: 1634

2. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday and Thursday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached at 571/272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1634

A handwritten signature in black ink, appearing to read "Diana B. Johannsen", with a long, sweeping horizontal line extending to the right.

Diana B. Johannsen
Primary Examiner
Art Unit 1634